

Claims 1-4 and 10 were rejected under 35 U.S.C. 102(b) as being anticipated by Kasugai et al. (U.S. Patent No. 5,104,472).

Claims 1-4 and 10 were rejected under 35 U.S.C. 102(e) as being anticipated by Pachciarz et al. (U.S. Patent Application No. 2001/0042752).

These rejections are traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the instant invention as claimed, and the cited prior art.

An aspect of the present invention, per claim 1, is an insert mold structure comprising a first part constituted from a thermoplastic material. A second part, coated with a paint made from the same material as the first part, is insert-molded into the first part.

The Examiner asserted that Hyde, Kasugai et al., and Pachciarz et al. disclose the claimed structure.

Contrary to the Examiner's assertions, Hyde, Kasugai et al., and Pachciarz et al. do not anticipate the claimed insert mold structure. Hyde, Kasugai et al., and Pachciarz et al. do not disclose that the second part is coated with a paint made from the same material as the first part as required by claim 1. Hyde discloses a valve 24 (second part) sealed by a parison wall 26 (first part). Kasugai et al. disclose a central tube 21 (second part) of metal molded in a base portion 23 (first part) and further molded in a blow mold 30 (another first part). Pachciarz et al. disclose a metal stud 28 and a base ring 22 (second part) encapsulated in plastic material (first part). However, neither Hyde, Kasugai et al., nor Pachciarz et al. disclose that the second part is coated with a paint made of the same material as the first part.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok*

*Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Hyde, Kasugai et al., and Pachciarz et al. do not disclose that the second part is coated with a paint made of the same material as the first part, Hyde, Kasugai et al., and Pachciarz et al. do not anticipate claim 1.

Applicant further submits that Hyde, Kasugai et al., and Pachciarz et al. do not suggest the claimed insert mold structure.

The dependent claims are allowable for at least the same reasons as the independent claims from which they depend, and further distinguish the claimed invention, for example claim 2 further requires that the coating is powder coating. Claim 3 further requires that the coated second part is heat-treated. Claim 4 requires that the first part is made of a resin and the second part is made of a metal. Claim 10 further requires that the melting point of the coating is lower than the melting point of the first part. The prior art does not suggest the claimed insert mold structure with these additional limitations.

In view of the above remarks, Applicants submit that this application should be allowed and the case should be passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Bernard P. Codd". The signature is fluid and cursive, with the first name "Bernard" and last name "Codd" being the most prominent parts.

Bernard P. Codd

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